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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,155	11/17/2003	Makiko Kobayashi	1046.1303	9446
21171 7590 01/28/2008 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER TANK, ANDREW L	
			ART UNIT 2173	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/713,155

Applicant(s)

KOBAYASHI ET AL.

Examiner

Andrew Tank

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-13,27,36 and 38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-13,27,36 and 38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

1. The following action is in response to the Request for Continued Examination (RCE) filed under 37 CFR 1.53(d) for the instant application on November 8, 2007. Applicants have properly set forth the RCE, which has been entered into the application. Accordingly, the amendment submitted November 6, 2007 has been entered and an examination on the merits follows herewith.
2. Claims 8, 9, 27, and 36 have been directly amended. Claim 38 has been newly added. Claims 1-5, 7, 14-26, 28-35 and 37 been canceled. **Claims 8-13, 27, 36, and 38** are pending and have been considered below.

Claim Objections

3. Applicant has canceled claims 25 and 34. Claims 25 and 34 were objected to in the Office Action of August 10, 2007. These objections are now moot and are presently withdrawn.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claim 36** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

- **Claim 36:** Claim 36 recites the limitation: “A computer readable medium embodying a program . . .” While this is normally acceptable, applicant further adds from the specification ([0142-0144]): “<<Readable-by-Computer Recording Medium>>” and “<<Data Communication Signal Embodied in Carrier Wave>>” The use of the term “embodying” in the claim language raises issue, in the broadest reasonable interpretation given in light of the specification, to claim 36 being drawn to the program being embodied by the carrier wave. A carrier wave is not a series of steps or acts and this is not a process. A carrier wave is not a physical article or object and as such is not a machine or manufacture. A carrier wave is not a combination of substances and therefore not a compilation of matter. Thus, a carrier wave does not fall within any of the four categories of invention. Therefore, claim 36 is not statutory.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
7. **Claims 27 and 36** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- **Claims 27 and 36** recite the limitation "the storage unit" in their respective lines 8-9 and 9-10. There is insufficient antecedent basis for these limitations in the claims.

Claim Rejections - 35 USC § 102

8. Applicant has canceled claims 1-5, 7, 20-26 and 29-35. Claims 1-5, 7, 20-26 and 29-35 were rejected, in the Office Action of August 10, 2007, under 35 USC § 102(e) as being anticipated by Croley (US 2002/0070973). These rejections are now moot and are presently withdrawn.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. **Claims 8-13, 27, 36, and 38** are rejected under 35 U.S.C. 102(e) as being anticipated by Snapper et al. (US 7,216,292), hereafter known as “Snapper”.

- **Claims 8, 27 and 36:** Snapper discloses a communication apparatus, method, and computer readable medium for relaying between a server and a terminal for receiving, from the server on a network, definition information of a screen containing a data input box for data specified by data identifying information and transmitting the data input to the data input box to the server (Abstract), comprising:
 - communicating with the server and the terminal via the network (col 6 lines 20-23:
“the user of client computer 204 can retrieve web pages from web servers”);

- storing, in a storage unit, the data input to the data input box (col 7 lines 7-11: “associates the values entered by the user”) together with the data identifying information (col 7 lines 10-12: “with the field identifiers and the URL for the web site and stores them in a data structure 207”);
- searching for the data corresponding to the data identifying information from the storage unit on transmitting to the terminal the definition information of the screen containing the data input box for the data specified by the data identifying information (col 7 lines 13-19: “Consequently, when the user visits different web site 202 and displays form 260, modified web browser 206 recognizes that some of the field identifiers user in form 260 are the same as or similar to field identifiers associated with a previous form, and the values associated with those fields are retrieved”); and
- correlating the searched data with the data identifying information specifying the data input box (col 7 lines 17-19: “some of the field identifiers user in form 260 are the same as or similar to field identifiers associated with a previous form, and the values associated with those fields are retrieved”),
- wherein in said communication, a definition information of a screen containing a data input box for data specified by data identifying information from the server is received (col 7 lines 12-13: “when the user visits different web site 202 and displays form 260”) and the definition information of the screen containing the data input box for data specified by the data identifying information together with the searched data correlated with the data identifying information is sent to the terminal (col 7 lines 13-

19: "Consequently, when the user visits different web site 202 and displays form 260, modified web browser 206 recognizes that some of the field identifiers user in form 260 are the same as or similar to field identifiers associated with a previous form, and the values associated with those fields are retrieved and suggested to the user at the time he or she beings to fill out the form 260.").

- **Claim 9:** Snapper discloses the apparatus as in claims 8 above, and further discloses that the storage unit is stored with plural pieces of data input to the data input box in the past(col 8 lines 42-45: "previously used form data values can be stored"), and the control unit sets one piece of data among the plural pieces of data into said data input box (col 7 lines 17-19: "the values associated with those fields are retrieved and suggested to the user at the time he or she beings to fill out the form 260") and adds to the definition information a piece of information for having the remaining data displayed as options in the vicinity of the input box (col 7 lines 29-33: "web browser 206 displays a pop-down list 205b suggesting previously used values for fields having the same or similar name").
- **Claim 10:** Snapper discloses the apparatus as in claim 9 above, and further discloses the apparatus comprising a determining unit determining a priority order of the data set into the data input box (col 8 lines 4-8: "Heuristics function 206b can be employed to generate suggestion lists according to various heuristics that can be optionally user-controlled. For example, suggested can be displayed in priority order . . . ").
- **Claim 11:** Snapper discloses the apparatus as in claim 9 above, and further discloses the apparatus comprising an arrangement unit determining a data arrangement order of the data displayed as the options (col 8 lines 4-8).

- **Claim 12:** Snapper discloses the apparatus as in claim 9 above, and further discloses the apparatus comprising an obtaining unit obtaining information for identifying a user of the terminal (col 15 lines 42-44: "the user is logged into the operating system"), wherein the storage unit is stored with the data in a way that relates the data to the information for identifying the user (col 15 lines 42-44: "the user's password can be used to encrypt the data"), and the control unit searches for the data corresponding to the data identifying information for every user (col 15 lines 5-11).
- **Claim 13:** Snapper discloses the apparatus as in claim 9 above, wherein the storage unit is stored with plural pieces of data identifying information related to the data (col 13 lines 19-29: "For example, COMMON NAMES may include three commonly used field identifiers for a user's name"), and the control unit searches for the data by any one piece of data identifying information among the plural pieces of data identifying information (col 13 lines 26-29: "so that when any one of these field identifiers is encountered, all of the values associated with any of them can be automatically suggested").
- **Claim 38:** Snapper discloses a method of relaying definition information of a screen containing an input box, comprising:
 - storing a value entered into an input box of a web page by a user (col 7 line 5-12: "the first time the user of a client computer 204 visits a web site 201 and enters his name, address, and telephone number into form 250") in association with an identifier defining information of a screen containing the input box (col 7 lines 5-12: "modified web browser 206 associates the values entered by the user with the field identifiers

and the URL for the web site and stores them into a data structure 207 for future use”); and

- displaying the value as an option for entry into the input box responsive to determination of an access of the web page by the user subsequent to said storing, where said value is retrieved using said identifier as a key and displayed when a comparison of said defining information stored matches definition information requested for said access of the web page (col 7 lines 13-19: “Consequently, when the user visits different web site 202 and displays form 260, modified web browser 206 recognizes that some of the field identifiers user in form 260 are the same as or similar to field identifiers associated with a previous form, and the values associated with those fields are retrieved and suggested to the user at the time he or she beings to fill out the form 260.”).

Response to Arguments

11. Applicant's arguments with respect to claims 8-9, 27, 36 and 38 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Kethireddy (US 7,062,711) – pertains to a user interface for providing search query syntax help.

- Bertram et al. (US 5,864,340) – pertains to a predictive input method.
- Racine et al. (US 7,278,113) - pertains to a user interface with dynamic form configurations.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Tank whose telephone number is 571-270-1692. The examiner can normally be reached on Mon - Thur 0730-1500 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ALT
January 17, 2008

/Kieu D. Vu/
Kieu D. Vu
Primary Examiner